



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
---------------	-------------	----------------------	---------------------

09/141,495 10/22/93 90EHM

M 203268

KILLOS, EXAMINER

12M2/1204

LYON & LYON
633 WEST FIFTH STREET
STE. 4700
LOS ANGELES, CA 90071-2066

ART UNIT	PAPER NUMBER
----------	--------------

1204

DATE MAILED: 12/04/95

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

- ☐ This application has been examined ☐ Responsive to communication filed on 25 Aug 95 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire Three month(s), — days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☐ Claims 1-61 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.

3. ☐ Claims 1-32 are allowed.

4. ☐ Claims 1-3 and 33-61 are rejected.

5. ☐ Claims _____ are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).

12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

Serial Number: 08/141,496

-2-

Art Unit: 1204

This is in response to the communication filed 25 August 1995.

The claims are 1-61.

Claims 1-3 are again rejected under 35 USC 112 second paragraph as being indefinite for failing to particularly point out and distinctly claims the subject matter which applicants regard as the invention. The term "a ligand" is all embrative of all ligands which activate Retinoid X receptors in preference to Retinoid acid receptors while the specification is limited to certain structural formulae. Applicants arguments based on the breadth of the claims have been considered but are not persuasive.

Claims 1-3 are again provisionally rejected under 35 USC 101 as claiming the same invention as application Serial No. 08/141,914 or 08/141,246. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Serial Number: 08/141,496

-3-


Art Unit: 1204

Claims 33-39, 40-44, 45-61 are rejected under 35 USC 112 par. 2 as being overly broad and indefinite. The claims must structurally define the compounds use to *effect* the desired treatment.

Any inquiry concerning this communication should be directed to Examiner Paul Killos at telephone number (703) 308-1235.

A facsimile center has been established in Group 1200, room 3C10. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4556 or 305-3592.

KILLOS; aco
November 22, 1995


PAUL J. KILLOS
PRIMARY EXAMINER
ART UNIT 126